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*In re* Application of BLUMENTHAL ET AL.

Appl. No.: 10/647,895

Filed: August 26, 2003

For: Method And Apparatus For Aerating Bodies Of  
Water

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: **DECISION ON PETITION**  
: **FOR SUPERVISORY**  
: **REVIEW**  
: 37 CFR 1.181  
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This is a decision on the petition filed February 24, 2006 for supervisory review of an examiner's action under 37 CFR 1.181. Petitioner requests the relief of reversal of the examiner's holding that the Appeal Brief filed on December 13, 2005 is non-compliant.

The petition is **Dismissed**.

On February 3, 2006, the examiner issued a Notification of Non-Compliant Appeal Brief. The examiner held the brief non-compliant because the content of the "Summary of Claimed Subject Matter" contained extraneous subject matter outside of a concise explanation of each independent claim as required by 37 CFR 41.37(c)(1)(v). The examiner additionally indicated this section of the Appeal Brief should be limited to only a discussion of the features in the sole independent claim. Petitioner argues in the instant petition that the examiner's position is "without foundation" and that having the summary contain more information than what is claimed is "beneficial to the Board because such a Summary provides a better understanding of what the specific structure is." Petitioner additionally states that a further benefit of having advantages of the invention in this Summary is that the "Board is apprised, during its initial consideration of the Brief, of what advantages Appellants' structure has." Petitioner finally notes that "Clearly, the Board is able to determine by reading the claims and arguments what Appellants' regard as their invention".

37 CFR 41.37(c)(1)(v) requires that the "Summary of Claimed Subject Matter" section of the Appeal Brief contain a concise explanation of the subject matter found in each independent claim. The intent of the new rule and the changing of this section of the Brief from the previous "Summary of the Invention" to "Summary of Claimed Subject Matter", is to allow patent applicants, as the authors of the application and creators of the invention, to assist the Board in claim construction as to what applicants believe the scope of the recited features found in each independent claim are. It also assists

the Board in contrasting the relative positions of the examiner and the applicants. Finally, requiring that each independent claim be discussed at a minimum instead of just representative claim(s) or the invention as a whole assists the Board in their determination of which embodiments are covered or not covered by the various independent claims in the application, as well as how the scopes of the various claims vary relative to one another (see Comment 53 of Board of Patent Appeals and Interferences (BPAI) Final Rule, **69 Federal Register 49976**).

In reviewing petitioner's "Summary of Claimed Subject Matter", it is clear that there is no distinct concise explanation of the subject matter found in each independent claim. Petitioner's Summary, rather, is a discussion that intermixes features found in the sole independent claim, features found in some dependent claims, as well as some features found in *none* of the claims, without identifying which is which. Thus, in relation to petitioner's initial and third arguments, the examiner's holding that the Brief is non-compliant does in fact have "foundation" in both the letter and intent of the rule, and requiring a new Summary would assist the Board as intended by the rule. Since the entire intent of the rule is to give the Board the appellants' position of the scope of the claims by having applicants map the terms used in each independent claim to the explanation in the specification and elements of the figures, intermixing other claimed elements as well as other argument (advantages over the prior art, etc.) without distinction clouds the issue in this regard. The petitioner's current "Summary of Claimed Subject Matter" does not assist the Board in claim construction and determination of the scope of the independent claim for this reason. Finally, with regards to petitioner's second argument, petitioner is partially correct that the Summary does not have to be limited to *only* what is in the independent claims. If appellants wish to additionally assist the Board in claim construction for the dependent claims they are free to do so, and in fact are required to do so in 37 CFR 41.37(c)(1)(v) for dependent claims that contain "means" and are argued separately. However, the dependent claim limitations should be clearly identified and not intermixed with the core concise explanation of each independent claim so as to not cloud the claim construction of these independent claims. For above given reasons it is believed that the examiner's discretion in holding petitioner's Appeal Brief of December 13, 2005 non-compliant was not abused, and petitioner is not entitled to the relief requested.

Telephone inquiries regarding this decision should be directed to S. Joseph Morano, Supervisory Patent Examiner for Art Unit 3617, at (571) 272-6684. Telephone inquiries regarding the status of the claims and other examination related issues should be directed to the examiner of record, Stephen P. Avila, at (571) 272-6678.

  
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John Love  
Director, Technology Center 3600

SJM: 3/22/06

*SM*